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EXAMINER

KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
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2614

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/234,559

Filing Date: January 20, 1999

Appellant(s): RAMAKESAVAN, SUNDARAM

Timothy N. Trop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 05/27/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct. However, there are additional issues not identified by appellant. As is listed in the Grounds of Rejection (below), there is the issue of anticipation of claims 14 and 16 based on Dan, and obviousness based on Dan applied to claims 15 and 24.

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Furthermore, appellant has, without giving a reason, addressed the anticipation rejection (of claim 14 only) under the heading of the first of the only two issues listed, both which involve obviousness rejections.

(7) *Grouping of Claims*

The rejection of claims 1-26 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,453,779	DAN et al	9-1995
5,537,473	SAWARD	7-1996

(10) *Grounds of Rejection*

The following three ground(s) of rejection are applicable to the appealed claims:

Claims 14 and 16 stand rejected under 35 U.S.C. 102(b) as being anticipated by Dan et al.

This rejection is set forth in a prior Office Action, mailed on 02/17/04.

Claims 15 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. This rejection is set forth in a prior Office Action, mailed on 02/17/04.

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Claims 1-13, 17-23, 25 and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. in view of Saward. This rejection is set forth in a prior Office Action, mailed on 02/17/04.

(11) Response to Argument

In section A, appellant starts by referring to the previous Board decision and the previously-applied Russo reference, but neither that decision nor the reference is relevant because neither is ~~not~~ part of the currently pending issues.

Appellant then attempts to counter the rejection of claim 1 by arguing that the examiner's alleging an "implicit assumption" is not proper. That "implicit assumption" is perfectly legitimate and further corroborated by the secondary reference. Since video-on-demand (VOD) is inherently characterized or defined by programming accessible only to paying customers, it very reasonably follows that there is an implicit assumption that that access remains restricted to paying customers (thereby denying those who may want the programming without paying for it, so dictated by a business perspective). The Board and the appellant are informed that the examiner recognizes *that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.* See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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In this case, the skilled artisan readily acknowledges general extant characteristics of video-on-demand, including the unsaid or implicit assumption that access to programming is only provided to paying customers, and denied to non-paying customers. That measures would therefore be taken to maintain and ensure limited access is a wholly legitimate assumed consideration, implicit by the nature of video-on-demand communication.

Dan is virtually silent on the standard and inherent hardware (clearly seen in his bare-bones system components so basically labeled, noting his sole arrangement in Fig. 1) because he focuses on the pause/resume data communication between the user and provider, listing various flow charts.

The secondary teaching which describes well-known circuit components of a video-on-demand system (PPV) was brought in, because it explicitly discloses hardware used to make certain that presentation is only allowed to paying customers, in a similar on-demand set-up. Saward clearly incorporates this decryption for a reason. The well-known descrambling (called decryption in col. 3 lines 25-26) is included to ensure that non-paying customers will not get viewable programming if communication is made. Its function and purpose are well known in the art. It is in his receiver for practical reasons. He does not have to explain its fundamental operation or implied purpose, just as he does not have to state that a power supply is even included and if so, that it is for providing power to each system component in a specific sequence and time period by virtue of conductive connections.

Appellant in fact argues that consideration of such measures is irrelevant, although his claim 1 recites decryption. Because that limitation is recited, the examiner appropriately considered it relevant and accordingly and properly addressed it in the rejection.

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Appellant goes on to emphatically state that the (examiner's) points are "*totally unsupported, totally irrelevant, and totally impermissible since they simply conclude what is obvious based on nothing in the reference*". The examiner has instead provided a clear and rational explanation of how the two references are compatible and combinable.

It is further noted that although he brings it up in his first point, appellant is this time conspicuously silent on the previous rejection based on the previously applied Russo patent, regarding decryption in VOD. Russo (who could still be applied against appellant's claims) also incorporates decryption hardware (element 114), and in the identical field of endeavor. Russo incorporates it for a reason understood by the skilled artisan.

Appellant continues to argue at length the examiner's rejection based on Dan by referring to that previous rejection which is not relevant because it has been removed. Appellant contends that the examiner's rejection (which of instead now involves Dan and Saward) is unsupported conjecture and completely improper (page 8 of the Brief), again providing support from the previous Board decision which only and specifically addresses the rejection made using Russo.

However, what the examiner presented is not conjecture but wholly valid grounds as to why Dan as modified by Saward cover the appellant's limitations. There are clearly inherent characteristics in Dan since he discloses (in what is presumed valid: 35 USC 282) two-way communication of data between client/server through a network, focusing on starting, stopping, pausing, and resuming programming upon request (e.g. col. 2 lines 26-35). A data structure (Fig. 2), travels as a code through the two-way medium, comprises a serial component data stream (Fig. 2) as it is sent to the server through the network as a request. The request is processed (noting the various flow charts), and the server accordingly sends back a data structure to the

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client which is decoded and enables starting, stopping, pausing, and resumption of the client's video programming system. Dan is capable of doing all of this despite disclosing any interfacing, any actual signal communicating, processing or controlling. Since his system so claimed is enabling and since these features are required for operation, they all therefore must be inherent.

When modified by Saward, the descrambling (as well as the remaining circuitry in Dan necessary for reproducing programming for presentation) would be in operation at the client upon being prompted by a response from the server, which first processed the request from the client. The return signal (response) transmitted back through the network medium is decoded as required to generate signaling in a form capable of being processed by the specific components of the client device. This is all done in an organized, controlled manner made possible by circuitry internal to the server and client. This is not conjecture nor is it improper. This is all evident to one of ordinary skill in the art.

Appellant then contends there is no reason to believe that a code must be read to enable play at a later time. This issue is irrelevant, however inaccurate it is with respect to the ability of Dan. Appellant's allegation is presented in the context, once again, of the previous rejection based on Russo which is not existent.

Appellant then argues the anticipation rejection of claim 14 (in this section headed by a and obviousness rejection directed to a different claim), by stating that text referred to by the examiner in Dan is not irrelevant to what is claimed. The examiner disagrees and instead repeats herein that when the client sends a pause request (the data structure code communicated through the network to the server), the eventual resumption code (pausing requiring resumption or else it

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would be a “stop” rather than a “pause”), *must* be communicated in response, which is therefore automatic, and in code form in order for that request to also be processed. Appellant contends that coding is not present in Dan, but only the request. It is very clear, however, that the request is in the form of a code as it must be sent to and recognized by the server for processing. The section referred to by the examiner (which was indicated as being exemplary in the Office action) is thereby relevant, and in fact goes beyond that to why it is applied to the claim, as is other text, such as col. 3 lines 39-45. The ensuing text goes on to describe how the server makes the decisions as to how to respond to the client (done automatically as prompted by the requests), which ultimately prompts a resume mode at the client station.

Appellants further arguing that a code to “enable play to resume at a later time” is not disclosed, is contrary to the required operation of Dan. The client end must accordingly be sent a response (in code similar to the data structure shown in Fig. 2, as a signal sent through the network) to resume play “at a later time” (language that is redundant, incidentally), to relieve the pause condition.

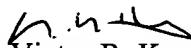
Now addressing the issue identified in section **B**, appellant argues essentially the same point as that regarding claim 14, and mentions a controller. (Saward is not explicitly discussed). The examiner accordingly maintains the above position countering appellant’s arguments involving claim 14. In addition, both Dan and Saward carry out all of the processing in a controlled manner, specific control structure not explicitly disclosed. Applicant further states that there is no reason why the “*reference*” (Dan? Saward?) would necessarily receive a request code and in response receive a code. Dan (alone or as modified by Saward) would receive a code (the client end, that is) because it is locked in a pause mode and must be activated by the

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server to unlock it for resumption of play. Appellant's further arguing as to why automatically providing the code is "absolutely necessary" (although such a condition is not an issue) is not totally clear to the examiner. What is necessary is for the client device to resume play first prompted by an upstream pause request, the request being processed and answered by the server automatically (the flow charts indicating such) to enable ultimate resumption of play back at the client end.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Victor R. Kostak
Primary Examiner
Art Unit 2614

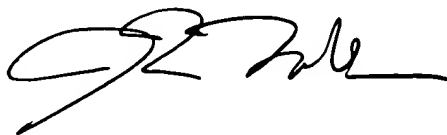
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August 4, 2004

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